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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,153	03/24/2004	Terry N. Morganti	10450	5268

7590 06/14/2005
Mark G Bocchetti
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER

SMITH, RICHARD A

ART UNIT	PAPER NUMBER
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2859

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/808,153

Applicant(s)

MORGANTI ET AL.

Examiner

R. Alexander Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 and 10-13 is/are allowed.
- 6) ☒ Claim(s) 14, 15, 23 and 24 is/are rejected.
- 7) ☒ Claim(s) 9, 16-22, 25 and 26 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 August 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. The numbering of claims is not accordance with 37 CFR 1.75(f) which requires the original claims shall be numbered consecutively in Arabic. Therefore, misnumbered claim 25-27 has been renumbered as claim 24-26.

Drawings

2. The drawings are objected to because:
- a. The line from "50" in figure 1 should be directed to the arrows defining the gap.
 - b. "22" in figure 4 lacks a line pointing to the terminal edge.
 - c. Figure 3 as drawn with respect to the skive plate assembly is incomprehensible to the examiner since there are numerous lines that should not be intersecting or crossing (near 28) making the understanding of the figure difficult to follow.
 - d. Furthermore, the intersecting and crossing of lines also extends to the element shown in the middle of figures 1 and 3 on the left side, which the examiner presumes is a bolt. However, these lines do not affect the understanding of the invention.
 - e. With respect to claims 1 and "a distance between the terminal edge and the base plate decreases with distance from said skive plate central portion" and claim 9 and "the gap between the terminal edge and the base plate is constant along the length of the skive plate": The examiner objects to these limitations under 37 CFR 1.83(a) because it is unclear to the examiner if these limitations are shown in the figures. If they are shown, then where?

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 9, 16 and 22 are objected to because of the following informalities:

Claim 9: "a terminal edge" spanning lines 1-2 should start with --the-- in order to properly refer to its antecedent.

Claim 16 is objected to under 35 CFR §1.75(b) since claim 16 is essentially a duplicate of claim 3.

Claim 22:

a) The claim is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. This claim is objected to as being non-limiting since the limitations have already been disclosed in claim 14.

b) "a terminal edge" spanning lines 1-2 should start with --the-- in order to properly refer to its antecedent.

c) "a gap" in line 2 should start with --the-- in order to properly refer to its antecedent.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 14, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 6,295,436 to Morganti et al.

Morganti discloses the limitations of claims 14, 23 and 24 when the skive plate is 42 of figure 3, the base plate is 36 with 37, the skive plate attachment being 43 that intermittently interrupts (i.e., at the ends of) the slot 39, the terminal edge being the front edge of 42 that the skives 41 extend over, and the constant gap is as shown in figure 4 given the straightness of the terminal edge as shown in figure 3.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morganti et al.

Morganti et al. teaches all that is claimed as discussed in the above rejections of claims 14, 23 and 24 except for air gap slot being approximately 3/16 to 1/2 inches wide along the length.

With respect to the air gap slot being approximately 3/16 to 1/2 inches wide along the length: This limitation is only considered to be the "optimum" values of the width of the air gap slot disclosed by Morganti et al., as stated above, that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on

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accommodating the size of the decurler roller 40. See In re Boesch, 205 USPQ 215 (CCPA 1980).

Allowable Subject Matter

7. Claims 1-8 and 10-13 are allowable.

8. Claims 9, 16 and 22 would be allowable if rewritten to overcome the claim objections set forth in this Office Action and to include all of the limitations of the base claim and any intervening claims.

9. Claims 17-21, 25 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

10. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related assemblies.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Alexander Smith whose telephone number is 571-272-2251.

The examiner can normally be reached on Monday through Friday from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. Alexander Smith', with a large, stylized initial 'R' and a long horizontal stroke extending to the right.

R. Alexander Smith
Primary Examiner
Technology Center 2800

RAS
June 13, 2005